

REMARKS

Claims 1-44 are pending in the application.

Claim Rejection under 35 U.S.C. § 102(e)

Claims 1-5, 21-25, 41 and 42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Daniell et al. (US Publication No. 2004/0054736) ("Daniell"). This rejection is respectfully traversed.

Claim 1 recites a method for providing interoperability of email and instant messaging services. The method comprises receiving a request by an email recipient to respond to an email message using an instant message application, the email message received from an email sender. The method further comprises retrieving an instant message address for the email sender from storage, associating the instant message address of said email sender with an instant message composed by the email recipient, and transmitting the instant message to the instant message address using the instant message application. An email address associated with the email sender is mapped to a corresponding instant message address associated with the email sender.

Daniell discloses an object architecture for integration of email and instant messaging. The Action points to FIG. 10 and paragraphs 0006 and 0089 as allegedly showing the step of receiving a request by an email recipient to respond to an email message using an instant message application, the email message received from an email sender. Paragraph 0006 of Daniell describes how, in the past, vendors offered an IM roster as a single pane in the main email window and permitted a user to launch a separate IM client to chat with a contact that was listed on the IM roster. As explained in this portion of Daniell, this scenario provided nothing more than a single view of an email client and an IM client. Paragraph 0089 of Daniell describes how an IM start button 1050 shown in FIG. 10 permits a user to launch an IM session with various contact from a read window 412. The read window 412 provides IM internet presence information for each of the email addresses shown on the read window 412. Thus, if a user receives an email message from a sender that has an IM Internet presence, e.g., Larry@yahoo.com, an IM Internet presence indicator is displayed for the sending email address, as well as any cc'd email addresses. In paragraph 0091, Daniell describes how the user may launch an IM session with the email sender (Larry@yahoo.com), since it is indicated that Larry@yahoo.com is present.

Nowhere in Daniell is there a disclosure or suggestion of receiving a request by an email recipient to respond to an email message using an instant message application, the email message received from an email sender. While Daniell describes permitting an email recipient to respond to an email message from a sender with an instant message, if the email sender is “present” in IM Internet session, Daniell does not describe the email recipient receiving a request to respond to an email message using an instant message application, as set forth in claim 1.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the * * * claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As Daniell fails to disclose or suggest receiving a request by an email recipient to respond to an email message using an instant message application, Daniell does not anticipate claim 1. Therefore, claim 1 is considered allowable over Daniell.

If the position is maintained that all the features recited in claim 1 are disclosed in Daniell, it is respectfully requested that it be specifically pointed out where in Daniell there is a basis for this view.

Claims 21 and 41 recite similar features as claim 1 and are considered allowable for at least the same reasons. Claims 2-5, 22-25, and 42 depend from and include all the features recited in claims 1, 21, and 41, respectively, and are considered allowable for at least the same reasons.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 6, 26, 43 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniell et al., in view of Szeto et al (US Publication No. 2004/0215721) (“Szeto”); Claims 7-12 and 27-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniell in view of Danon (US Publication No. 2003/0110211) (“Danon”), and further in view of Davis et al. (US Publication 2004/0158610) “Davis”); Claims 13 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniell in view of Danon; Claims 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniell in view of Atencio et al. (US Publication 2004/0210450) (“Atencio”); Claims 19, 20 and 39 stand

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rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniell in view of Roskind (US Publication 2004/0128540) (“Roskind”); and Claim 40 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniell in view of Roskind, and further in view of Weiss (US Patent 6,930,598) (“Weiss”). These rejections are respectfully traversed.

With regard to the rejection of claims 6, 26, 43, and 44, the Action relies on Szeto for the features missing from Daniell. Szeto discloses a system and method for instant messaging using an email protocol. Szeto fails to disclose or suggest receiving a request by an email recipient to respond to an email message using an instant message application, the email message received from an email sender, as set forth in independent claims 1, 21, and 41. Thus, Szeto fails to make up for the deficiencies of Daniell with regard to claims 1, 21, and 41. As claims 6, 26 and 43-44 depend from and include all the features recited in claims 1, 21 and 41, respectively, claims 6, 26, and 43-44 are considered allowable over any combination of Daniell and Szeto.

In addition, claim 6 recites, among other features, receiving a request by an instant message recipient to respond to an instant message using an email application. The Action admits that this feature is missing from Daniell. The Action points to Szeto for this feature.

In Szeto, if an instant message is sent intended for a recipient that uses email, the instant messaging server 118 recognizes that the recipient is an email user and forwards the instant message to an EIM manager 116 (See para. 0036 of Szeto and FIG. 1). The instant message is converted into an email message by the EIM manager 116 and delivered to the email recipient. Thus, in Szeto, a request is not received by an instant message recipient to respond to an instant message using an email application. Rather, the decision as to which application to use (instant messaging or email) is made by the IM server 118. Thus, Szeto fails to disclose or suggest receiving a request by an instant message recipient to respond to an instant message using an email application and thus further fails to make up for the deficiencies of Daniell, with regard to the features recited in claim 6. For at least this additional reason, claim 6 is considered allowable over any combination of Daniell and Szeto.

Claim 26 recites similar features as claim 6 and is considered allowable over any combination of Daniell and Szeto for at least the same reasons.

With regard to the rejection of claims 7-12 and 27-32, the Action relies on Danon and Davis for the claimed features missing from Daniell. Danon discloses a method and system
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for communicating, creating, and interacting with content between and among computing devices. Davis discloses client proxying for instant messaging. Neither Danon nor Davis disclose or suggest receiving a request by an email recipient to respond to an email message using an instant message application, the email message received from an email sender, as set forth in independent claims 1 and 21. Thus, Danon and Davis fail to make up for the deficiencies of Daniell with regard to independent claims 1 and 21. As claims 7-12 and 27-32 depend from and include all the features recited in claims 1 and 21, respectively, claims 7-12 and 27-32 are considered allowable over any combination of Daniell, Danon, and Davis.

With regard to the rejection of claims 13 and 33, the Action relies on Danon for the features missing from Daniell. As explained above, Danon fails to disclose or suggest receiving a request by an email recipient to respond to an email message using an instant message application, the email message received from an email sender, as set forth in independent claims 1 and 21. Thus, Danon fails to make up for the deficiencies of Daniell with regard to independent claims 1 and 21. As claims 13 and 33 depend from and include all the features recited in claims 1 and 21, claims 13 and 33 are considered allowable over any combination of Daniell and Danon.

With regard to the rejection of claims 14-18, the Action relies on Atencio for the claimed features missing from Daniell. Atencio discloses a system architecture for self-provisioning services and a method of use. Atencio fails to disclose or suggest receiving a request by an email recipient to respond to an email message using an instant message application, the email message received from an email sender, as set forth in independent claim 1. Thus, Atencio fails to make up for the deficiencies of Daniell with regard to claim 1. As claims 14-18 depend from and include all the features recited in claim 1, claims 14-18 are considered allowable over any combination of Daniell and Atencio.

With regard to the rejection of claims 19, 20, and 39, the Action relies on Roskind for the claimed feature missing from Daniell. Roskind discloses implicit access for a communications pathway. Roskind fails to disclose or suggest receiving a request by an email recipient to respond to an email message using an instant message application, the email message received from an email sender, as set forth in independent claims 1 and 21. Thus, Roskind fails to make up for the deficiencies of Daniell with regard to independent claims 1 and 21. As claims 19 and 20 and claim 39 depend from and include all the features

recited in claims 1 and 21, respectively, claims 19, 20 and 39 are considered allowable over any combination of Daniell and Roskind.

With regard to the rejection of claim 40, the Action relies on Roskind and Weiss for the features missing from Daniell. Weiss discloses a home gateway server appliance. Weiss fails to disclose or suggest receiving a request by an email recipient to respond to an email message using an instant message application, the email message received from an email sender, as set forth in independent claim 21. As noted above, these features are also missing from Roskind. Thus, Roskind and Weiss fail to make up for the deficiencies of Daniell with regard to independent claim 21. As claim 40 depends ultimately from and includes all the features recited in claim 21, claim 40 is considered allowable over any combination of Daniell, Roskind and Weiss.

For at least the reasons given above, claims 6-20, 26-40, and 43-44 are considered allowable over the proposed combination of cited documents. Accordingly, Applicants respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fees be charged to Deposit Account No. 09-0458.

Respectfully submitted,

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